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TECHNOLOGY CENTER R3700

**Scott E. Johnston, Applicant Pro Se, Appellant**

**Appeal From Final Rejection of**

**James F. Hook, USPTO / GAU 3752, Primary Examiner**

**Appn. Number: 09/312,992**

**APPELLANTS' REPLY BRIEF**

This is in reply to examiner's answer dated July 1, 2003.

REAL PARTY IN INTEREST

Unchanged.

RELATED APPEALS AND INTERFERENCES

Unchanged.

STATUS OF CLAIMS

Unchanged.

STATUS OF AMENDMENTS

Unchanged.

SUMMARY OF INVENTION

Unchanged.

ISSUES

Unchanged.

CLAIMS APPEALED

Unchanged.

RESPONSE TO ARGUMENT

Pages 3-11 of the examiner's answer includes *re-written* arguments taken from the examiner's final rejection (paper 20). It is unclear why it was included. The material was already addressed in the appeal brief, and there is no reason to address it again in this reply brief.

The examiner's answer beginning on page 12, contains an opening statement that includes two separate issues. The first issue is a presentation regarding "flow of material" through a silo. This is not a new issue, and will be discussed later in proper order. The second issue however is new and must be dealt with at this time. The examiner is suggesting that it is somehow acceptable to develop a definition for the word "pipe" based on the appellant's application. It is unclear how the examiner has arrived at this position. The specification is quite clear that the large diameter products identified are new to spirally formed pipe, that they are, in fact, the result of the applicant's invention. The last sentence on page 1 of the specification is also clear that the large diameter "*products*" of the past were made from bolted, or welded sections of material. It could be that the examiner has intentionally reduced "spirally formed pipe" as used in the claims to "pipe" just to make such an argument. The appellant did not refer to these products as "pipe", therefore the argument is not valid. Additionally, when the examiner refers to "figure 1" he is referring directly to the appellants' invention to define what a pipe can be and clearly "figure 1" of the appellants' application was not available to those skilled in the art, thus the examiner is engaging in hindsight reasoning which is not allowed under 35 U.S.C. § 102.

For clarity the remainder of this reply brief will utilize the same numbering system applied in the appeal brief.

#### ARGUMENT REGARDING ISSUE 1

1.) Regarding argument 1, the appellant presented, with sound reasoning and direct quotations, that the silo of "Reed" consists of numerous components which are integral to the structure, and

that the removal of items and use of a portion of the silo as a pipe is not taught by the reference. The silo is physically different than a pipe. The examiner's answer provides a full page (page 13) explanation of how the "wall" of a silo can be considered a pipe. The explanation provided by the examiner is developed from a dictionary definition and the opinion of the examiner. There is no discussion comparing the structure of "Reed" to the appellants' claims, no quotations from the reference have been provided. The examiner simply states, "Reed can show more structure than what applicant claims and still anticipate the structure if it is a similar structure capable of performing in the same manner", but does not provide support for this position. The examiner makes no attempt to address the cites and authorities presented by the appellant. The "E.I. du Pont de Nemours & Co. v. Polaroid Graphics Imaging, Inc." cite is clear enough, any degree of physical difference, however slight, would certainly include "more structure than what applicant claims". The examiner dismisses obviousness and inherency issues as being erroneous, this of course, is not an answer. The cites and authorities presented are appropriate. ***The examiner has not presented an answer that would overcome argument 1***, this reference cannot be utilized as an anticipation. Also, the examiner has again referred to the appellants' application as providing support for a definition of pipe, which is in fact hindsight reasoning, as discussed before.

2.) Regarding argument 2, the appellants' argument insisted that, if the examiner believes that the silo presented in the reference is inherently a pipe, it is the responsibility of the examiner to prove it, and as discussed above, the examiner simply dismisses such an argument as erroneous, ***which is not an answer***. The examiner has not provided *evidence* or *scientific reasoning*. In fact, the examiner claims to be convinced that the silo of "Reed" is a "pipe", and that settles it. It is clear

that the, In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981) and In re Swinehart, 439 F.2d 210, 213, 169 USPQ 226, 229 (CCPA 1971), cites as presented are appropriate. ***The examiner has not presented an answer that would overcome argument 2,*** this reference cannot be utilized as an anticipation.

3.) Regarding argument 3, the appellant argued that the examiner's presentation regarding "flow of material" through a silo, would not be a concept considered by those skilled in the art, that the examiner's reasoning is, in fact, abstract reasoning, not scientific reasoning. ***The examiner has not provided an answer to overcome this argument.***

The examiner (page 14, lines 8-9) has indicated "that the applicant was having trouble understanding", but perhaps the examiner is confused. It might be the reference itself, is to blame. A reference so obscure in its terminology that two conflicting theories as to its meaning may be deduced therefrom and supported by equally plausible arguments is too indefinite to be utilized as an anticipation. (see Cimiotti Unhairing Co. et. al v. Comstock Unhairing Co. et. al., 115 Fed. Rep. 524.) Both the appellant and the examiner cannot be right. The appellant does not believe the reference is confusing, a "silo" is not a "pipe" it is quite simple, but the examiner apparently disagrees.

4.) Regarding argument 4, the appellant presented an argument, that the examiner's teaching regarding the body portion of the "silo" being a pipe was the result of hindsight reasoning.

The examiner answer states (page 14, lines 13-15), "using applicants specification to arrive at the meaning of the term "pipe" is not considered hindsight reasoning", but provides no support for this statement. This argument is actually a continuation from the examiner's opening remarks, as discussed before, the appellant did not refer to large diameter "products" of the past, as "pipe".

The appellants' invention allows for silos to be made from "spirally formed pipe" but, once a silo is built it would cease to be a pipe. Likewise, if you were to remove components from a silo to create a pipe the end result would be a product that would no longer function as a silo. ***The examiner has not presented an answer that would overcome this argument.***

5.) Regarding argument 5, the appellants' argument focused on the examiner's use of the term "tubular object" within the rejection. The examiner had indicated that the silo reference of "Reed" discloses a "tubular object which is a pipe". The examiner was attempting to suggest that pipe somehow has an inherent ability to have a top and bottom structure as would be required to make a silo. The examiner now states "the roof of a silo is not part of the tubular wall of the silo either". It is unclear how the examiner intends the reader to interpret this, therefore ***the examiner has not presented an answer that would overcome argument 5.***

6.) Regarding argument 6, the appellant argued that the examiner had dismissed an argument presented by the appellant identifying an inherent characteristic of pipe. The examiner implies on page 15 of the answer, that the argument is not applicable. The examiner avoids the issue of his responsibility to provide an argument to illustrate how a silo could inherently be a pipe, then puts that responsibility onto the pipe, by suggesting that a "pipe" is inherently the "wall of a silo".

This of course is merely one, of many possible uses for a pipe, not an inherent characteristic. *The examiner has not presented an answer that would overcome argument 6*, this reference cannot be utilized as an anticipation.

7.) Regarding argument 7, the appellant argued that the new invention of Large Diameter Spirally Formed Pipe provides for unappreciated advantages over the prior art. *The examiner essentially dismisses the argument once again*, suggesting there “can be no advantages over the prior art”. The examiner has tried to reduce the advantage argument to an issue of the method of production used to produce the pipe and to some extent the examiner is correct, however it is not simply the “novel method and apparatus” of the appellant that makes the argument valid. Those skilled in the art of spiral pipe production are well aware of the speed with which a spiral pipe can be produced, the “Cortec” reference for example suggests that a 15 ft diameter, 75 ft long pipe could be produced in about 25 minutes. It is not possible for the prior art apparatus to produce a silo with such efficiency. *The cites and authorities presented are valid.*

8.) Regarding argument 8, the appellant argued that the new invention of Large Diameter Spirally Formed Pipe solves *unrecognized problems*, the examiner’s answer (page 15, lines 15-21) again dismisses the argument, suggesting that the applicant “has solved no unrecognized problems”, considering the pipe was allegedly anticipated by the reference, and goes on to say, “regardless of what it is intended to be used for”. It would seem that solving an unrecognized problem would generally include some form of *intended use* no matter what the invention might be. As stated in

the appeal brief, it is unrealistic to think that a grain silo anticipates the appellants' pipe, when there is no suggestion that a silo could be utilized to solve the same problems as solved by that pipe. This actually illustrates that the "Silo" reference of Reed does not function in the same way to produce the same results as the appellants' invention. The cite of Pacific Technica Corp. v. U.S., 11 Cl.Ct. 393, is appropriate. ***The examiner has not presented an answer that would overcome argument 8.***

9.) Regarding argument 9, the appellant argued that the examiner had dismissed the appellants' argument regarding lack of implementation. It is implied, that the reference possesses *inherent characteristics* that make it's use as a pipe inevitable, hence, a certainty, therefore anticipated. The fact that the Reed patent was filed 50 years ago, and no one, as yet has done what the examiner has implied is anticipated certainly brings into question the validity of that assertion. The examiner's answer (pages 15-16) is unresponsive to the actual argument, suggesting that the appellant was implying that "Reed" had never made silos before. There would be no reason for the appellant to make such a suggestion. ***The examiner has not presented an answer that would overcome this argument.***

10.) Regarding argument 10, the appellant argued that the silo reference of "Reed" teaches away from it's use as a "pipe". The argument was presented to illustrate that the reference does not anticipate or render obvious the appellants' invention. ***The examiner's answer*** (pages 15 lines 2-5) ***does not challenge this argument.***



11.) Regarding argument 11, In the final rejection, the examiner discounted the Board of Appeals quotation relied on, as it related to this rejection. To clarify, the appellant suggested that the entire second paragraph of page 4 would apply. The suggestion that the cites and authorities presented would only apply to references which contain different embodiments is not supported. The examiner's answer (page 16, lines 5-10) continues to assert the same position, and suggests how those in the art might order silo, as pipe is immaterial. The following is taken directly from the Board of Appeals decision (Paper No. 17, page 4):

Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of claimed invention RCA Corp. v. Applied Digital Data Sys., Inc., 730 F .2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir 1984). In other words, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. Scripps Clinic & Research Found v. Genentech Inc., 927 F .2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991) When the claimed invention is not identically disclosed in a reference, and instead requires picking and choosing among a number of different options disclosed by the reference, then the reference does not anticipate. Thus, the invention must have been known in the art in the detail of the claim; that is, all of the elements and limitations of the claim must be shown in a single prior art reference, arranged as in the claim. See Karsten Mfg. Corp. v. Cleveland Gulf Co., 242 F .3d 1376, 1383, 58 USPQ2d 1286, 1291(Fed. Cir. 2001); Akzo N.V. v. International Trade Commission, 808 F .2d 1471, 1480, 1 USPQ2d 1241, 1245-46 (Fed. Cir. 1986), cert. denied, 107 S. Ct. 2490 (1987); In re Arkley, 455 F .2d 586, 587-88, 172 USPQ 524, 526 (CCPA 1972).

The above excerpt provides a grouping of reliable cites and authorities that are valid when considering whether a reference is anticipated. The suggestion that the reference to "Reed" does not contain different embodiments is irrelevant. The examiner has gone beyond the teaching of the reference, the appellants' invention is not identically disclosed, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. The suggestion that contractors do not order 100 feet of silo, Pipe manufactures do not produce 100 feet of silo. Silo manufactures do not produce 100 feet of silo and sell it as pipe, is relevant to understanding the difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. ***The examiner has not presented an answer that would overcome argument 11.***

12.) Regarding argument 12, the appellant presented an argument to show that the examiner's presentation regarding the need for external supports on grain silos was in error. The examiner did not address this argument. The appellant then provided an alternate theory for the existence of these supports, utilizing an above ground swimming pool as an easy to understand somewhat comparable structure. The examiner simply dismisses the argument as "irrelevant because the forces seen by a pool wall are not equivalent to those seen by a silo". The examiner does not provide any support for this position. The appellants' argument is valid, a silo wall would not logically be strong enough to be used as a pipe, and the reference does not suggest such a use anyway. ***The examiner has not presented an answer that would overcome this argument, the reference of "Reed" cannot be utilized to support a rejection under 35 U.S.C. § 102.***

13.) Regarding argument 13, the appellant has repeatedly argued the examiner's responsibility to provide evidence or scientific reasoning to support the rejection. The examiner continues to insist that the dictionary, and now the appellants' application provide "the best understanding for the word pipe", *the examiner has not provided an answer that would overcome this argument.*

14.) Regarding argument 14, the appellant presented an argument that it must be demonstrated that one of ordinary skill in the art would be *enabled* to make the claimed invention, that there needs to be a "silo" to "pipe" transition disclosed. Without providing this, the examiner is actually suggesting that the body portion of the silo is *obviously* a pipe, which is not allowed under 35 USC § 102. The examiner's answer (page 17, lines 3-4) states, "it is in error to state the examiner is using Reed in any type of obviousness rejection", *there is no actual discussion of the appellants' argument.* The General Elec. Co. v. Hoechst Celanese Corp., cite is appropriate. As stated in the appeal brief, based on arguments 1-14 above, including cites and authorities, *the decision of the examiner must be reversed*; which action the appellant now respectfully requests.

#### ARGUMENT REGARDING ISSUE 2

15.) Regarding argument 15, the examiner has chosen to consider this argument applying to McDonald as being the same as the Reed arguments. It is then suggested, that "the examiner will only address portions of the arguments which stray from the silo argument", it is unclear what the examiner is referring to. The examiner suggests that arguments pertaining to obviousness and inherency are not appropriate, and simply implies that examiner's redefining the term pipe

“would include structures such as silos”. The McDonald reference is not identical to the Reed reference. The appellant argued that the removal of items and use of a portion of the silo as a pipe is not taught by the reference. It is readily apparent that a silo is physically different than a pipe. The *E.I. du Pont de Nemours & Co. v. Polaroid Graphics Imaging, Inc.*, cite, as well as the excerpts from the MPEP are valid, ***the examiner has not presented an answer that would overcome this argument.***

16.) Regarding argument 16, the appellant presented an argument compelling the examiner to provide proof that the silo of McDonald is inherently a pipe, but the examiner has simply dismissed such an assertion. The *In re Oelrich*, and *In re Swinehart* cites are valid. ***The examiner has not presented an answer that would overcome this argument.***

17.) Regarding argument 17, The examiner considers that the arguments are essentially repeated arguments that were used against Reed above, ***no additional answer is presented by the examiner.*** Therefore, all of the above reasons as presented in arguments 1-17, including cites and authorities, apply to the McDonald reference as well. ***The decision of the examiner must be reversed,*** which action the appellant now respectfully requests.

#### ARGUMENT REGARDING ISSUE 3

18.) Regarding argument 18, the examiner has chosen to consider this argument applying to Steuber as being the same as the Reed arguments. It is then suggested, that “the examiner will

only address portions of the arguments which stray from the silo argument", it is unclear what the examiner is referring to. The examiner suggests that arguments pertaining to obviousness and inherency are not appropriate, and simply implies that examiner's redefining the term pipe "would include structures such as silos". The Steuber reference is not identical to the Reed reference, in fact it pertains more particularly to a method of constructing a tank. The appellant argued that the removal of items and use of a portion of the tank as a pipe is not taught by the reference. It is readily apparent that a tank is physically different than a pipe. The E.I. du Pont de Nemours & Co. v. Polaroid Graphics Imaging, Inc. cite, as well as the excerpts from the MPEP are valid, ***the examiner has not presented an answer that would overcome this argument.***

19.) Regarding argument 19, the appellant presented an argument compelling the examiner to provide proof that the tank of Steuber is inherently a pipe, but the examiner has simply dismissed such an assertion. The In re Oelrich, and In re Swinehart cites are valid. ***The examiner has not presented an answer that would overcome this argument.***

20.) Regarding argument 20, The examiner considers that the arguments are essentially repeated arguments that were used against Reed above, ***no additional answer is presented by the examiner.*** Therefore, all of the above reasons as presented in arguments 1-17, including cites and authorities, apply to the Steuber reference as well. ***The decision of the examiner must be reversed,*** which action the appellant now respectfully requests.

ARGUMENT REGARDING ISSUE 4

21.) Regarding argument 21, the appellant presented an argument that the examiner's rejection is contingent upon the earlier "Reed, McDonald and Steuber" rejections being valid, therefore the current rejection is not valid. *The examiner did not address this argument.*

22.) Regarding argument 22, the appellant argued that the modifying reference of the Handbook does not teach of variation in corrugation profiles for pipes above 120 inches in diameter, all profiles are the same beyond this size, therefore the rejection is not valid. The examiner's answer (page 18, lines 7-13) provides a broad conclusory statement, claiming that features of a pipe can be proportional, but does not provide any support for the statement. *The examiner answer does not address the appellants' argument.*

23.) Regarding argument 23, the appellant presented an argument that the examiner's rejection is based on the Reed, McDonald and Steuber disclosing the appellants' invention of claim 1 and 2, when such has not been established, therefore it is necessary for the examiner to explain this modification as well as any subsequent modifications. *The examiner's answer does not address this argument.*

24.) Regarding argument 24, the appellant pointed out that the examiner made the statement "If faced with a problem related to the size of a strip", without identifying what the nature of the problem might be, how it might be known to those skilled in the art. The examiner's answer

(page 18, lines 13-22) provides a rather elaborate example of why the “size of a strip” might be increased, but again has made no attempt to connect the statement to some teaching found within any of the references. The suggested motivation and expectation of success provided by the examiner is based on circular reasoning, and is not supported by the references. The examiner also says, “this in no way means the references in their silence of showing larger strips is in any way teaching away from the modification”, which illustrates that the examiner has not found these teaching within the references. *It also does not actually address the appellants' argument* regarding the references teaching away from the suggested modification. For all of the above reasons as well as the cites and authorities as presented within the appeal brief, *the decision of the examiner must be reversed.*

#### ARGUMENT REGARDING ISSUE 5

25.) Regarding argument 25, the appellant presented a summary of the teachings for both of the references to illustrate that the references are *individually complete*, also since neither reference provides a teaching to combine the references, it is an *unsuggested combination*. The examiner's answer beginning on page 19 second paragraph, provides no response to this argument, but instead provides a theory supporting the rejection based on a presentation regarding “combining equivalents”. The examiner considers section 2144.06 of the MPEP as providing authority for his assertion. The cites relied on deal with composition of formulas, or mixtures. In each of the cases a powder or chemical, which is already in use for a specific application is being combined with another powder or chemical also already in use for that same application. The invention of the

appellant and Cortec deal with "Spirally Formed Pipe", and McFatter deals with a method and apparatus for "Storage Tank Construction Procedures". The examiner has not provided an explanation for how the McFatter and Cortec references can be seen as being like a powder or chemical, and the appellants' invention is some type of composition. The examiner states (page 19, line 11-15), that the reference of "McFatter is used to teach that it was known that large spiral pipe structures could be manufactured", which seems to be an attempt to say McFatter is about spiral pipe and, Cortec is about spiral pipe, therefore they may be combined as equivalents. The examiner has not provided any evidence that the tank shown in the McFatter reference is a pipe, also there would be no reason to combine the references, since Cortec teaches of smaller structures than McFatter. ***The examiner has not provided an answer that would overcome argument 25***, the *Ex parte Clapp*, 227 USPQ 972, 973 (BPAI 1985) and, *Uniroyal, Inc. v. Rudkin -Wiley Corp.*, 837 F. 2d 1044, 1052, 5 USPQ 2d 1434, 1052 (Fed. Cir.) cert. denied, 488 U.S. 825 (1988) cites are appropriate.

26.) Regarding argument 26, the appellant refuted the examiner's suggestion that "McFatter discloses a device", that could be used to make the Cortec pipe larger. ***The examiner has not provided an answer to this argument.***

27.) Regarding argument 27, the appellant refuted the examiner's suggestion that both references are concerned with the same type cylindrical or tubular objects, therefore the motivation to combine them exists. The examiner may have been attempting to answer this argument with the presentation regarding "combining equivalents", as addressed above, but in using this argument



*the examiner has dismissed any need for providing motivation stemming from the references, which is in error.* The In re Fitch, 972 F.2d 1260, 1266 n.4, 23 USPQ2d 1780, 1783-84 n.4 (Fed. Cir. 1992), citing In re Gordon, 773 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984) cites are appropriate.

28.) Regarding argument 28, the appellant refuted the examiner's suggestion that "Both articles use the same methods and the same types of apparatus", and suggested the rejection is based on nothing more than the examiner's own statement. *The examiner's current position is no longer based on the methods and apparatus being equal*, but instead focuses on the pipe and tank being equal. The examiner relies on his own characterization of the McFatter reference to produce his theory, therefore *the cites regarding broad conclusory statements are still valid.*

29.) Regarding argument 29, the appellant argued that the examiner's comments regarding the expectation of success are not supported by any teaching found within the references, that the examiner has developed a theory based on possibilities that the examiner has manufactured. *The examiner has not addressed this argument*, Section-- 706.02 of the MPEP applies. For all of the above reasons, *the decision of the examiner must be reversed*, which action the appellant now respectfully requests.

#### ARGUMENT REGARDING ISSUE 6

30.) Regarding argument 30, the appellant presented a summary of the teachings for both of the references to illustrate that the Cortec reference would only gain the benefit of the arch shape up

to 120 inches, by the suggested combination. The combination of the references beyond this size, is an *unsuggested combination*. It is apparent that *unsuggested modifications* would be required for the combination to meet the appellants' claim language. The examiner has not presented an answer addressing *unsuggested combination, or unsuggested modifications*. Instead the examiner attempts to define the teachings of the Handbook as illustrating information that is not actually found within the reference. The examiner's answer (page 20, last paragraph) refers to table 1-1 on page 38 of the Handbook, then discusses Cortec, then returns to the Handbook, to imply that some teaching has been established regarding reshaping a spirally formed pipe. The teachings of the Handbook have been thoroughly explored, the table on page 38 teaches of several products, it is provided to illustrate the variety of sizes and shapes available, the overall focus is on structural plate products, although there is sufficient teaching on pages 39 and 40 to realize that spiral pipes up to 120 inch in diameter could be included as well. For the examiner to state, "the motivation is set forth above in the rejection", *completely ignores the argument* presented. *The examiner has not provided an answer that would overcome argument 30*. The *Ex parte Clapp*, 227 USPQ 972, 973 (BPAI 1985) and *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F. 2d 1044, 1052, 5 USPQ2d 1434, 1052 (Fed. Cir.) cert. denied, 488 U.S. 825 (1988) cites are valid.

31.) Regarding argument 31, the appellant presented additional discussion on spiral pipe and structural plate pipe sizes as taught by the Handbook reference. The examiner had previously dismissed the argument. It was also presented that it requires invention to produce spirally formed pipe as claimed. The examiner's answer (page 21), restates the issue of structural plate

not requiring reshaping, embellishing the concept and suggesting it provides proof that the "table" teaches "forming flattened spiral pipe". It is unclear which table the examiner is referring to, table 1-1 of the Handbook certainly does not provide any teaching pertaining to "forming" flattened pipe. Page 40 of the Handbook, "DESCRIPTION OF CORRUGATIONS", defines the corrugations with which spirally formed pipes may be made and page 50 provides the range of sizes available for "Pipe-Arches" made from these corrugations, there is no actual teaching of forming "Pipe-Arches", it is just shown that they exist. The examiner simply dismisses the remainder of the argument and proclaims any argument pertaining to what is naturally occurring is immaterial. The *Ex parte Clapp*, 227 USPQ 972, 973 (BPAI 1985) and *Edison Electric Light Co. v. U.S. Electric Lighting Co.*, 52 Fed. Rep. 300 cites are appropriate. ***The examiner has not presented an answer, or has not presented an answer that would overcome the argument.***

32.) Regarding argument 32, the appellant presented that the floor is a vital part of the teaching of Cortec. It serves as a platform for pre assembled floor plans, that the useful volume is actually decreased when using the arch shape for the Cortec house, that Cortec would be unsatisfactory for its intended purpose as a result of the suggested modification. The examiner's answer (page 21) suggests there is "no need or use for the part of the pipe existing below the floor". However, the Cortec reference states "A fully pre assembled floor unit with built-in utilities is inserted to complete construction", and goes on to say "Many design options are available". The implication is that "built-in utilities" such as, plumbing, heating, wiring, etc., are most likely located beneath the floor, and there is "design" freedom, gained by "inserting" a "floor unit" into the structure.

The examiner's suggestion does not provide solutions, it simply raises more questions. Arched shaped pipes as found within the Handbook reference are made with deep corrugations, they are curved on the bottom and have a substantial corner radii. The examiner's structure would require some type of built up floor to provide a smooth level surface, and no doubt plumbing, electrical and air conditioning would be considered. Structures such as homes and offices must be built to building codes. Additionally the examiner has also suggested that shapes, possessing the same periphery dimension would contain the same volume, which is not correct. Useful volume is determined by the intended use of the pipe, arched pipe provides for greater useful volume for storm drain applications because it has been determined that water generally flows through the lower half of pipes. In the case of the Cortec reference, a building such as a home or office needs to provide room for the occupants to move around, an arch shape reduces that room. The In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir.1984) cite is valid. ***The examiner has not presented an answer that would overcome the appellants' argument.***

33.) Regarding argument 33, the appellant was questioning a statement from the examiner's final rejection, the appellant had argued that the references teach away from suggested modification, Larger sizes of arch pipe are made from bolted together structural plate, not spirally formed pipe, this is the teaching of the Handbook reference. The Handbook would suggest using structural plates instead of the spirally formed pipe of Cortec. ***The examiner has not challenged this argument, the decision of the examiner must be reversed;*** which action the appellant now respectfully requests.

## ARGUMENT REGARDING ISSUE 7

34.) Regarding argument 34, the appellant asserted that there is no suggestion to combine these references, and that unsuggested modifications would be required. The references teach away from the suggested combination. ***The examiner's answer*** (page 22, second paragraph) ***does not address this argument***. The examiner attempts to provide support for the rejection based on a misrepresentation of the teachings of table 1-1 on page 38 of the Handbook. The table referred to does not provide any teaching regarding pipes that are "later reshaped into arch shapes". Then the examiner refers to "the MPEP section above", something about "the overlapping of references", teaches the modification of the Handbook by Cortec. The examiner has not developed the basis for concluding that there is a "combining equivalents" theory worth exploring, he does not even make the effort to use those terms, or actually mention section 2144.06, we are left to complete the argument for him. The Handbook reference includes information about spirally formed pipe up to 120 inches in diameter, and the Cortec reference teaches of spirally formed pipe up to 15 feet in diameter. The Handbook, in view of Cortec does not require a "combining equivalents" theory to present that a spirally formed pipe up to 15 feet in diameter would be obvious, but neither reference teaches anything regarding reshaping pipes. The presentation of large arched shapes only proves that large arched shapes exist, the Handbook reference teaches that they exist based on the structural plate manufacturing method. It is clear that ***the appellants' argument with cites is valid, the decision of the examiner must be reversed***.

35.) Regarding argument 35, the appellant again asserted that unsuggested modifications would

be required, that the examiner does not provide a reason for the modification. The examiner's answer refers to table 1-1 of the Handbook reference as showing "arch shaped pipes in excess of 144 inches" then seems to focus on whether spiral pipes can be made up to 15 feet in diameter, which has never been challenged by the appellant. ***The examiner has not presented an answer, or has not presented an answer that would overcome the argument presented by the appellant.***

"The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on the applicant's disclosure".

In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). A broad conclusory statement regarding the obviousness of modifying a reference, standing alone is not "evidence".

E.g., McElmurry v. Arkansas Power & Light Co., 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993). In the absence of some teaching found within the reference, ***the examiner's rejection is based on nothing more than the examiner's own broad conclusory statements.***

36.) Regarding argument 36, the appellant again asserted, it should be noted that ***the examiner has not addressed the appellants' arguments*** regarding, *unsuggested modification, unsuggested combination*, and that the references *teach away* from the suggested combination and/or modification. The examiner has not provided a valid teaching or suggestion to make the claimed combination and that there would be a reasonable expectation of success. ***The decision of the examiner must be reversed***, which action the appellant now respectfully requests.

## ARGUMENT REGARDING ISSUE 8

37.) Regarding argument 37, the appellant presented a summary of the teachings for both of the references to illustrate that both references are *individually complete*, neither reference provides a teaching to combine the references, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. The examiner's answer (page 22-23) does not provide any statement to refute the appellants' contention that the references are individually complete. Instead the examiner makes an attempt to provide that there is motivation to combine the teachings based on an erroneous suggestion that McFatter teaches of spirally formed pipe up to 31 feet in diameter. Of course there is no teaching in McFatter to support this suggestion, the examiner has not provided any quotations from the McFatter reference. The examiner simply has not provided any support for his suggestion. ***Argument 37, along with cites and authority have not been challenged by the examiner. The decision of the examiner must be reversed***, which action the appellant now respectfully requests.

38.) Regarding argument 38, the appellant questioned how this rejection would be applied to claims 5-9, and also asserted that the rejection is based on the examiner's own "redefining of the references for clarity". The rejection is based on nothing more than the examiner's own broad conclusory statement. A broad conclusory statement regarding the obviousness of modifying a reference, standing alone is not "evidence". E.g., McElmurry v. Arkansas Power & Light Co., 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993). "Mere denials and conclusory

statements, however, are not sufficient to establish a genuine issue of material fact.”; In re Sichert 566 F.2d 1154, 1164, 196 USPQ 209, 217 (CCPA 1977). ***The examiner has only addressed*** the part of the argument pertaining to arched pipes, ***again relying on a misrepresentation*** of table 1-1. ***The remainder of argument 38, along with cites and authority have not been challenged by the examiner. The decision of the examiner must be reversed***, which action the appellant now respectfully requests.

39.) Regarding argument 39, the appellant discussed at length that the examiner was attempting to teach equivalencies of manufacturing processes, leading to a discussion that the examiner had asserted, that the appellant “has demonstrated in figure 1 of the instant application that one skilled in the art of forming sheet spirally into objects can use this technology to form buildings, silos, tanks, culverts, and pipes”, and then implies that “others would be equally skilled enough to understand the equivalence of the prior art and expect success”. The examiner’s answer (page 24) attempts to suggest that the examiner was only trying to show “how one would interpret the word “pipe” based the applicants disclosure”, of course as discussed above this is not the case.

***The examiner has not presented an answer that would overcome argument 39, the decision of the examiner must be reversed***; which action the appellant now respectfully requests.

40 .) Regarding argument 40, the appellant discussed that the examiner did not address the argument that the references *teach away* from the suggested combination and/or modification.

***The examiner has not challenged this argument***, the decision of the examiner must be reversed.

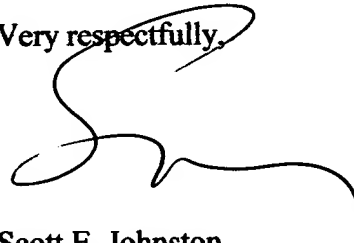


41.) Regarding argument 41, the appellant pointed out that it is important to note that the appellant has recently received patent 6,000,261 for a Portable Spiral Pipe Manufacturing System and 6,260,403 for a Large Diameter Arching Machine, both of which are necessary to produce the appellants' Large Diameter Spirally Formed Pipe. The examiner has been made aware of this on numerous occasions, and *the examiner's answer does not challenge this argument*, therefore the *decision of the examiner must be reversed*, which action the appellant now respectfully requests.

#### CONCLUSION

Many years have passed since I first filed for this patent as a provisional application (May 1998), it has cost considerable time and money. The examiner repeatedly indicated that he did not wish to waste the time of the Board of Appeals, it would be nice if he had considered my time to be of value as well. *Please accept this appeal, and Reverse the Examiner.*

Very respectfully,



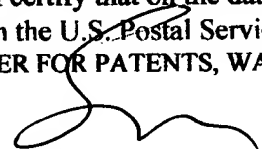
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**Certificate of Mailing:** I certify that on the date below this document and referenced attachments, if any, will be deposited with the U.S. Postal Service as first class mail in an envelope addressed to: "ASSISTANT COMMISSIONER FOR PATENTS, WASHINGTON, DC 20231."

July 31, 2003

  
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Scott E. Johnston, Applicant/Appellant